

As a courtesy to the Examiner, the Applicant resubmits herewith a copy of the Information Disclosure Statement filed on March 19, 2008. The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the above-referenced Information Disclosure Statement.

The Applicant respectfully requests that a misfiled Form PTO-1449 from application Serial No. 11/002,945 be removed from the present application Serial No. 09/832,867. A copy of the misfiled Form PTO-1449 appears in the Image File Wrapper as follows: "04-07-2008 1449 List of References cited by applicant and considered by examiner PROSECUTION 2." Through no fault of the Applicant, it appears that the 1449 was improperly associated with the present application. Therefore, the Applicant respectfully requests the Examiner's assistance in removing the above-referenced Form PTO-1449 from the present application.

Claims 1, 2, 4-10, 13, 14 and 65-77 are pending in the present application. Claims 67-77 have been withdrawn from consideration by the Examiner (Box 4a, Office Action Summary; page 2, Paper No. 20071202). Accordingly, claims 1, 2, 4-10, 13 and 14 are currently elected, of which claims 1 and 2 independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 5 of the Official Action rejects claims 1, 2, 4-10, 13 and 14 as obvious based on the combination of U.S. Patent No. 6,909,114 to Yamazaki, U.S. Patent No. 6,238,754 to Shohara and U.S. Patent No. 5,990,542 to Yamazaki. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or

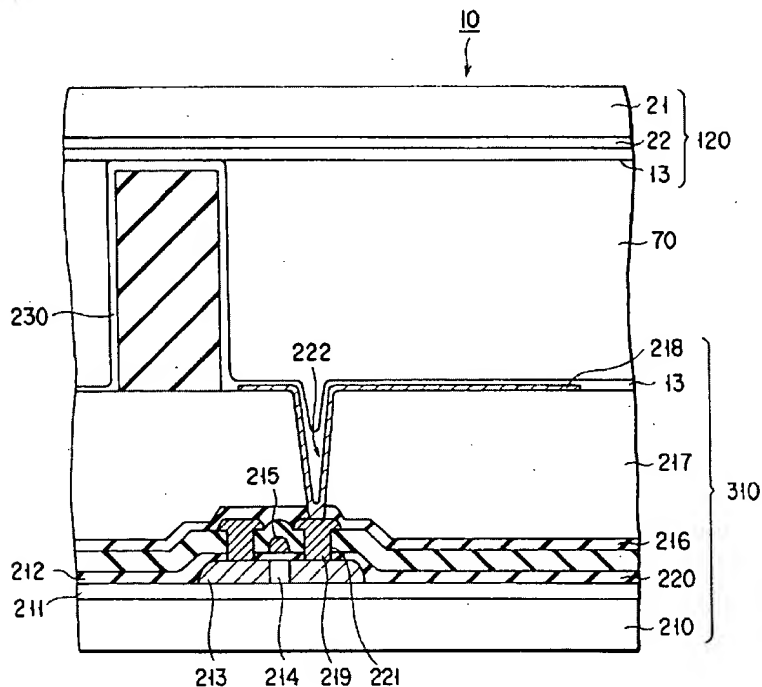
references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Initially, it is noted that the current rejection appears to be nearly the same as the previous rejection except that the Official Action has newly cited U.S. Patent No. 5,990,542 to Yamazaki (page 3, line 3); asserts that Yamazaki '114 teaches a resin film 308 (item (k), page 3, lines 28-29); changes the reference to the pixel electrode from Figure 35B of Yamazaki '114 to Figure 12B of Yamazaki '114 (page 4, lines 4-5); and asserts that Yamazaki '542 teaches the feature "at least a part of the resin is in contact with the protecting film" (page 4, lines 16-24). However, the Official Action does not address the deficiencies in Yamazaki '114 and Shohara and the lack of a reason to combine the two references to achieve the features of the present invention. In other words, Yamazaki '542 does not cure the deficiencies in Yamazaki '114 and Shohara.

Specifically, independent claims 1 and 2 recite a pixel electrode on and in contact with a resin film over a coloring layer over a protective film in contact with a gate insulating layer and a second conductive film of an n-channel TFT. For the reasons provided below, Yamazaki '114, Shohara and Yamazaki '542, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

The Official Action now relies on a combination of Figures 2 and 12 of Yamazaki '114 to allegedly teach some of the features of the present invention. Although Figure

The Official Action now more narrowly relies on Figure 3 of Shohara. However, Figure 3 of Shohara (reproduced below) still merely appears to teach that the columnar spacer 230 (relied upon to teach the “resin film” of the present claims) is located beside pixel electrode 218, that the spacer 230 is provided between colored layer 217 and counter substrate 120, and that the spacer 230 maintains a predetermined distance for the liquid crystal layer 70.



Even if the Examiner were able to demonstrate a reason to apply the colored layer 217 of Shohara to Yamazaki '114, it appears that Shohara would teach forming such colored layer 217 directly in contact with and between a pixel electrode 218 and a

semiconductor structure. As such, it is not clear why the alleged combination of Yamazaki '114 and Shohara would necessarily teach or suggest a pixel electrode on and in contact with a resin film over a coloring layer over a protective film in contact with a gate insulating layer and a second conductive film of an n-channel TFT.

Yamazaki '542 does not cure the deficiencies in Yamazaki '114 and Shohara. Yamazaki '542 is relied upon to allegedly teach "at least a part of the resin (612) is in contact with the protecting film (611) (For Example: See Figure 6E)" (page 4, Paper No. 20080328). However, Yamazaki '114, Shohara and Yamazaki '542, either alone or in combination, do not teach or suggest the following features or that Yamazaki '114 and Shohara could or should be modified to include the following features: a pixel electrode on and in contact with a resin film over a coloring layer over a protective film in contact with a gate insulating layer and a second conductive film of an n-channel TFT.

Since Yamazaki '114, Shohara and Yamazaki '542 do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained.

Furthermore there is no proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Yamazaki '114, Shohara and Yamazaki '542 or to combine reference teachings to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be modified in the manner asserted in the Official Action, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the features of the present invention.

The test for obviousness is not whether the references "could have been" combined or modified as asserted in the Official Action, but rather whether the references should have been. As noted in MPEP § 2143.01, "The mere fact that

references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original). Thus, it is respectfully submitted that the standard set forth in the Official Action is improper to support a finding of *prima facie* obviousness.

The Official Action concedes that Yamazaki '114 does not teach “a coloring layer provided between the protecting film and the resin film” and “at least a part of the resin is in contact with the protecting film” (page 4, Paper No. 20080328). The Official Action relies on Shohara to allegedly teach “a coloring layer (217) provided between the protecting film (216) and the resin film (230)” (Id.). The Official Action asserts that “[it] would have been obvious ... to modify the semiconductor device of Yamazaki to include a coloring layer provided between the protecting film and the resin film as described in Shohara because it aids in providing good display characteristics” (Id.). The Applicant respectfully disagrees and traverses the above assertions in the Official Action.

Please incorporate the description of the deficiencies in Yamazaki '114 and Shohara noted in detail in the previously filed *Amendment* and *supra*. It is not clear why one of ordinary skill in the art at the time of the present invention would have had any reason to combine the various features of Yamazaki '114, Shohara and Yamazaki '542 to necessarily form a pixel electrode is provided over the resin film over a coloring layer over a protective film in contact with a gate insulating layer and a second conductive film of an n-channel TFT.

Therefore, the Applicant respectfully submits that the Official Action has not provided a proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Yamazaki '114, Shohara and Yamazaki '542 or to combine reference teachings to achieve the claimed invention.

In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed

invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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